



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,415	11/29/2001	Morris Wiginton III	42338.830001.001	5955

26582 7590 07/28/2005

HOLLAND & HART, LLP
555 17TH STREET, SUITE 3200
DENVER, CO 80201

EXAMINER

INGBERG, TODD D

ART UNIT	PAPER NUMBER
----------	--------------

2193

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,415

Applicant(s)

WIGINTON ET AL.

Examiner

Todd Ingberg

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-32 is/are pending in the application.
4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 and 21-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


TODD INGBERG
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 – 13 and 21 - 32 have been examined.

Claims 1, 4, 7, 11, 21, 29, and 32 have been amended.

Claims 14 – 20 have been canceled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has introduced a new term in the claims which is not defined and supported in the Specification. The term “*First User*” does not have sufficient written support in the Specification and is deemed new matter.

3. Claims 1 – 13 and 21 - 32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. “First User” critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant has redefined the role of “end User” to be more than one role.

The amended claims with new lacking written description are as follows

Claim 1

Art Unit: 2193

A method in a computer system for enabling the development of installation software, the method comprising the steps of:

- generating at least one question definition screen;
- entering at least one question on the at least one generated question definition screen, the at least one question entered being designed to solicit information from a first user relating to a business of the first user;
- determining whether additional information relating to the business of the first user is necessary to install a software package on a computer system of the first user, the software package comprising, executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; and
- if additional information is not necessary, compiling the at least one entered question into installation software designed to solicit information from the user relating to the business of the first user such that the software package can be installed on-a the system of the first user.

Claim 2

The method of claim 1 including encrypting the stored at least one entered question.

Claim 3

(original): The method of claim 1, including the step of saving the at least one question prior to a determination that additional information is not necessary.

Claim 4

The method of claim 1, including the step of providing links to help files, wherein such help files assist them first user in providing at least one response to the at least one question, the at least one response relating to the business of the first user.

Claim 5

The method of claim 4, further comprising the step of providing at least one default response for the at least one question, the at least one default corresponding to a generally accepted accounting principle.

Claim 6

The method of claim 4, including the step of emailing a question to a help reference.

Claim 27

A computer-readable medium having computer-executable instructions for performing the acts of claim 1.

Claim 7

An apparatus for enabling the development of installation software wizards, comprising:

- at least one memory;
- at least one executable file stored in the at least one memory;
- the at least one executable file comprising at least one; instruction for providing at least

Art Unit: 2193

one question definition screen;

a monitor;

at least one processing unit to execute the at least one instruction to display the at least one question definition screen to at least one intermediate user, the at least one processing unit includes at least one input so the at least one intermediate user can input at least a first question, the first question to solicit information from an end user relating to a business of the end user, such that a first end user can input business information specific to the first end user different than business information specific to second end user; and

a compiler to write all the received information, wherein the received information is saved for the first end user.

Claim 8

The apparatus of claim 7, wherein the at least one memory, the at least one monitor, the at least one processing unit, the at least one input device, and compiler are coupled by at least one of a bus protocol, a wireless protocol, an intranet protocol, an extranet protocol, and html protocols.

Claim 9

The apparatus of claim 7, wherein the at least one memory comprises at least one help file.

Claim 10

The apparatus of claim 7, wherein the at least one processing unit includes a security module.

Claim 11

A computer program product comprising: a computer usable medium having a computer readable code embodied therein for processing data to develop installation software wizards to assist end users in installing business related software on a computer system of an end user, the computer usable medium comprising: a question generation module configured to generate at least one question definition screen; a receiving module configured to receive at least one question designed to solicit information from a first end user relating to a business of the first end user; a determining module configured to determine whether the business related software requires additional information for the business related software installation for the first end user; a linking module configured to provide links to next questions if additional information is determined to be needed to install the business related software for the first end user; a saving module configured to save the at least one received question; and a compiling module configured to write the at least one received question saved by the saving module into the installation software wizard for the first end user.

Claim 12

The computer program product of claim 11, comprising: an encryption module configured to provided encryption.

Claim 13

The computer program product of claim 11, comprising: a help module configured to provide help relating to the at least one question.

Art Unit: 2193

Claim 21

A method for generating a software installation application to install business related software where the business related software requires business operating information from an end user to be properly installed, the business related information being specific to a business of a specific end user and necessary to install the business related software package for the specific end user; the method comprising the steps performed on a computer of identifying a plurality of business operating information necessary to install the business related software; generating at least one edit question screen; the at least one edit question screen having a first input field for an intermediate user to enter at least one question designed to solicit business operating information from an end user; the at least one edit question screen having a second input field for the intermediate user to insert jump information, the jump information linking to at least one next question designed to solicit additional business operating information from the end user based on a plurality of possible answers from the end user to the at least one question; inputting the at least one question and the jump information; determining whether additional business operating information is necessary to complete installation of the business related software; if additional information is necessary, generating a next question edit screen and inputting another at least one question and jump information; and if additional information is not necessary, compiling a business software installation application using generated questions and linked generated next questions to solicit business operating information from the end user.

Claim 22

The method of claim 21, further comprising the step of generating at least one help definition screen for each edit question screen.

Claim 23

The method of claim 21, further comprising the step of providing a default business operating information answer for each generated edit question screen.

Claim 24

The method of claim 21, further comprising the step of encrypting the inputted at least one question and jump information.

Claim 25

The method of claim 21 wherein the determining step includes comparing whether the inputted at least one question solicits all the plurality of business operating information necessary to install the business related software.

Claim 26

The method of claim 21, further comprising the step of saving the inputted at least one question and jump information prior to compiling the business software installation application.

Claim 28

Art Unit: 2193

A computer-readable medium having computer-executable instructions for performing the acts of claim 21.

Claim 29

A computer program product comprising: a computer usable medium having computer readable code embodied therein for processing data to create a business software installation application, the computer usable medium comprising: a business information solicitation module configured to generate and display an edit question screen, the edit question screen having a first input field for an intermediate user to enter a plurality of questions designed to solicit business operating information from an end user corresponding to a plurality of possible answers that are specific to the end user, and a second input field for the intermediate user to insert a plurality of jump information, the plurality of jump information corresponds to the plurality of possible answers and a business installation software application to a next question based on an answer to be provided by the end user;

an input module configured to accept input from the intermediate user regarding the plurality of questions, the plurality of possible answers, and the plurality of jump information; and a compiling module configured to write the plurality of questions, the plurality of possible answers, and the plurality of jump information into the business software installation application.

Claim 30

The computer program product of claim 29, further comprising a processor identification module configured to obtain computer system information about the system on which the business software package is being installed.

Claim 31

The computer program product of claim 30, wherein the computer information system information includes information necessary to load the computer program.

Claim 32

A computer program product: a computer usable medium having computer readable code embodied therein for processing data to install a business software application, the computer usable medium comprising

an identifying module configured to identify at least one software package to be installed;
a displaying module configured to display at least one question inputted by an intermediate user to solicit business operating information from at least first user needed to install the business software application on a stem of the first end user;

an input module configured to receive the business operating information solicited by the displaying module; and

a jump module configured to jump to a next question to solicit additional business operating information from the first user needed to install the business software application operating information, the jump module jumps to the next question based on jump information provided by the intermediate user and business operating information from the first at least east user; and a system configuration module configured to install the business software application once necessary business operating information is received.

Original Grounds of rejection maintained in view of rejection under 35 U.S.C.

112 First paragraph above.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-11, 13, 21 - 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the commercial product on a computer readable medium with memory and screen support "Setup Factory", User's Guide by Indigo Rose, 1998 (Factory) in view of "Profit: business management gets cute", PC Magazine, v12, n8, p54, April 27, 1993 (Profit).

3. are rejected under 35 U.S.C. 103(a) as being unpatentable over the commercial product on a computer readable medium with memory and screen support "Setup Factory", User's Guide by Indigo Rose, 1998 (Factory) in view of "Profit: business management gets cute", PC Magazine, v12, n8, p54, April 27, 1993 (Profit).

Claim 1 – Amendment entered in record not typed in to the following claims
Factory teaches a method in a computer system for enabling the development of installation software(Factory, page 5 first paragraph), the method comprising the steps of: generating at least one question definition screen (Factory, pages 19 – 20) ;

entering at least one question on the at least one generated question definition screen, the at least one question entered being designed to solicit information from an end user relating to a business of the end user (Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership);

Art Unit: 2193

determining whether additional information relating to the business of the end user is necessary to install a software package (Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership – more than one question present in article);

if additional information is necessary, providing links to next questions to solicit additional information; and

if additional information is not necessary, storing the at least one entered question into installation software designed to solicit information from the end user relating to the business of the end user such that the software package can be installed on a system of the end user (Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership).

Factory teaches a commercial product that enables users to install computer software based on the response to the interaction of the user (Factory, page 23, top of page). Profit teaches the installation Wizard asking business related questions to accounting package installation. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Factory and Profit because, custom installation of software optimizes resource utilization such as disk space.

Claim 3

The method of claim 1, including the step of: saving the at least one question prior to a determination that additional information is not necessary. (Factory, page 6, Finish and page 19).

Claim 4

The method of claim 1, including the step of: providing links to help files (Factory, page 22, Help Contents), wherein such help files assist the end user in providing at least one response to the at least one question, the at least one response relating to the business of the end user. Although, Profit states it Coaches the installation process and employs graphics, the Examiner can not make a determination if Profit alone meets the limitation. Profit teaches help files page 75. Profit teaches an installation Wizard for installing an accounting package with questions directed toward the business. Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to combine Factory with Profit to enable Help for business specific questions because it facilitates installation.

Claim 5

The method of claim 4, further comprising the step of providing at least one default response for the at least one question, the at least one default corresponding to a generally accepted accounting principle. (Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership).

Claim 6

The method of claim 4, including the step of: emailing a question to a help reference. Factory, page 7.

Claim 7

Art Unit: 2193

Factory teaches an apparatus for enabling the development of installation software wizards (Factory, page 22), comprising:

- at least one memory;
- at least one executable file stored in the at least one memory;
- the at least one executable file comprising at least one instruction for providing at least one question definition screen (Factory, pages 21 - 23);
- a monitor;
- at least one processing unit to execute the at least one instruction to display the at least one question definition screen to at least one intermediate user(Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership);, the at least one processing unit includes at least one input so the at least one intermediate user can input at least one question, the at least one question to solicit information from an end user relating to a business of the end user; (Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership); and a compiler to write all the received information; wherein the received information is saved (Factory, page 66). Factory teaches a commercial product that enables users to install computer software based on the response to the interaction of the user (Factory, page 23, top of page). Profit teaches the installation Wizard asking business related questions to accounting package installation. Therefore , it would have been obvious to one of ordinary skill in the art at the time of invention to combine Factory and Profit because, custom installation of software optimizes resource utilization such as disk space.

Claim 8

The apparatus of claim 7, wherein the at least one, memory, the at least one monitor, the at least one processing unit, the at least one input device, and compiler are coupled by at least one of a bus protocol, a wireless protocol, an intranet protocol (Factory, page 7 , email and the inherent requirement for the limitations above to send email) , an extranet protocol, and html protocols.

Claim 9

The apparatus of claim 7, wherein the at least one memory comprises at least one help file. (Factory, page 22, Help Contents and page 75).

Claim 10

The apparatus of claim 7, wherein the at least one processing unit includes a security module. Factory page 9.

Claim 11

Factory teaches a computer program product comprising: a computer usable medium having a computer readable code embodied therein for processing data to develop installation software wizards (Factory, page 22) to assist an end user in installing business related software on a computer system of the end user, the computer usable medium comprising (Profit as per claim 1) a question generation module configured to generate at least one question definition screen; a receiving module configured to receive at least one question designed to solicit information from an end user relating to a business of the end user(Profit, The first Wizard you see is the

Art Unit: 2193

Setup Wizard that asks a few questions about the type of business that you run and the form of ownership); a determining module configured to determine whether the business related software requires additional information is need for the business related software installation(Profit, The first Wizard you see is the Setup Wizard that asks a few questions about the type of business that you run and the form of ownership); a linking module configured to provide links to next questions if additional information is determined to be needed to install the business related software; a saving module configured to save the at least one received question (Factory, page 66); and a compiling module configured to write the at least one received (Factory, Step Three, page 19 – 20) question saved by the saving module into the installation software wizard. Factory teaches a commercial product that enables users to install computer software based on the response to the interaction of the user (Factory, page 23, top of page). Profit teaches the installation Wizard asking business related questions to accounting package installation. Therefore , it would have been obvious to one of ordinary skill in the art at the time of invention to combine Factory and Profit because, custom installation of software optimizes resource utilization such as disk space.

Claim 13

The computer program product of claim 11, comprising: a help module configured to provide help relating to the at least one question. (Factory, page 22, Help Contents and page 75).

Claim 21

Factory teaches a method for generating a software installation application (Factory as per claim 1) to install business related software where the business related software requires business operating information from an end user to be properly installed (Profit as per claim 1); the method comprising the steps performed on a computer of: identifying a plurality of business operating information necessary to install the business related software (Profit as per claim 1); generating at least one edit question screen; the at least one edit question screen having a first input field for an intermediate user to enter at least one question designed to solicit business operating information from an end user (Profit as per claim 1); the at least one edit question screen having a second input field for the intermediate user to insert jump information (Factory, page 6, Back, Next and Finish and page 19), the jump information linking to at least one next question designed to solicit additional business operating information from the end user based on a plurality of possible answers from the end user to the at least one question; inputting the at least one question and the jump information (Factory, page 6, Back, Next and Finish and page 19); determining whether additional business operating information is necessary to complete installation of the business related software; if additional information is necessary, generating a next question edit screen and inputting another at least one question and jump information (Factory, page 6, Back, Next and Finish and page 19); and if additional information is not necessary, compiling a business software installation application using generated questions and linked generated next questions to solicit business operating information from the end user (Profit as per claim 1). Factory teaches a commercial product that enables users to install computer software based on the response to the interaction of the user (Factory, page 23, top of page). Profit teaches the installation Wizard asking business related questions to accounting package installation. Therefore , it would have been obvious to one of ordinary skill in the art at

Art Unit: 2193

the time of invention to combine Factory and Profit because, custom installation of software optimizes resource utilization such as disk space.

Claim 22

The method of claim 21, further comprising the step of generating at least one help definition screen for each edit question screen. (Factory, page 22, Help Contents and page 75).

Claim 23

The method of claim 21, further comprising the step of providing a default business operating information answer for each generated edit question screen. Factory, page 27 and 59.

Claim 25

The method of claim 21 wherein the determining step includes comparing whether the inputted at least one question solicits all the plurality of business operating information necessary to install the business related software. Profit as per claim 5.

Claim 26

The method of claim 21, further comprising the step of saving the inputted at least one question and jump information prior to compiling the business software installation application. (Factory, page 6, Back, Next and Finish and page 19) .

Claim 27

A computer-readable medium having computer executable instructions for performing the acts of claim 1. Factory and Profit are both commercial products and have Wizards for installing software – executable.

Claim 28

A computer-readable medium having computer executable instructions for performing the acts of claim 21. Factory and Profit are both commercial products and have Wizards for installing software – executable

Claim 29

Factory teaches a computer program product comprising: a computer usable medium having computer readable code embodied therein for processing data to create a business software installation application, the computer usable medium comprising:

a business information solicitation module configured to generate and display an edit question screen, the edit question screen having a first input field for an intermediate user to enter a plurality of questions designed to solicit business operating information from an end user corresponding to a plurality of possible answers and a second input field for the intermediate user to insert a plurality of jump information, the plurality of jump information corresponds to the plurality of possible answers and a business installation software application to a next question based on an answer to be provided by the end user (Factory, page 6, Back, Next and Finish and page 19);

Art Unit: 2193

an input module configured to accept input from the intermediate user regarding the plurality of questions, the plurality of possible answers, and the plurality of jump information; and a compiling module configured to write the plurality of questions, the plurality of possible answers, and the plurality of jump information into the business software installation application (Factory, page 6, Back, Next and Finish and page 19). Factory teaches a commercial product that enables users to install computer software based on the response to the interaction of the user (Factory, page 23, top of page). Profit teaches the installation Wizard asking business related questions to accounting package installation. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Factory and Profit because, custom installation of software optimizes resource utilization such as disk space.

Claim 30

The computer program product of claim 29, further comprising a processor identification module configured to obtain computer system information about the system on which the business software package is being installed. Factory, page 18, selective installation.

Claim 31

The computer program product of claim 30, wherein the computer information system information includes information necessary to load the computer program. Factory, page 18, disk set.

Claim 32

Factory teaches a computer program product: a computer usable medium having computer readable code embodied therein for processing data to install a business software application (as per claim 1), the computer usable medium comprising

an identifying module configured to identify at least one software package to be installed (as per claim 1);

a displaying module configured to display at least one question inputted by an intermediate user to solicit business operating information from at least one end user needed to install the business software application (as per claim 1);

an input module configured to receive the business operating information solicited by the displaying module (as per claim 1); and

a jump module configured to jump to a next question to solicit additional business operating information (as per claim 21) from the at least one end user needed to install the business operating information (Factory, page 6, Back, Next and Finish and page 19), the jump module jumps to the next question based on jump information provided by the intermediate user and business operating information from the at least one end user; and

a system configuration module configured to install the business software application once necessary business operating information is received.

Factory teaches a commercial product that enables users to install computer software based on the response to the interaction of the user (Factory, page 23, top of page). Profit teaches the installation Wizard asking business related questions to accounting package installation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention

Art Unit: 2193

to combine Factory and Profit because, custom installation of software optimizes resource utilization such as disk space.

4. Claims 2, 12, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Factory and Profit as applied to claim 1 above, and further in view of basic use of Encryption as taught by Computer Security Basics from 1991 (Encryption).

Claim 2

The method of claim 1, including encrypting the stored at least one entered question. Factory teaches the use of passwords. Passwords must be stored to enable validation. Encryption teaches encrypting passwords page 65. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the use of passwords of Factory with Encryption because access control makes systems secure.

Claim 12

The computer program product of claim 11, comprising: an encryption module configured to provided encryption. as per claim 2.

Claim 18

The computer program product of claim 17, further comprising: a security module configured to provide encryption. As per claim 2.

Claim 24

The method of claim 21, further comprising the step of encrypting the inputted at least one question and jump information. As per claim 2 and Factory completing password moving to another screen.

Response to Arguments

5. Applicant's arguments with filed April 25, 2005 have been considered but are moot in view of the new ground(s) of rejection. And moot in view of written description and new matter rejections under 35 U.S.C. 12 First paragraph. Examiner provides information on relevant arguments in view of new unsupported matter rejection under 112 First paragraph.

Arguments Directed Toward Claim 1

"Claim 1, as amended, is directed to a method in a computer system for enabling the development of installation software, the method comprising the steps of (a) generating at least one question definition screen; (b) entering at least one question on the at least one generated

Art Unit: 2193

question definition screen, the at least one question entered being designed to solicit information from a first user relating to a business of the first user; (c) determining whether additional information relating to the business of the first user is necessary to install a software package on a computer system of the first user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; (d) if additional information is necessary, providing links to next questions to solicit additional information; and (e) if additional information is not necessary, compiling the at least one entered question into installation software designed to solicit information from the first user relating to the business of the first user such that the software package can be installed on the system of the first user.

The cited references, taken alone or in combination, provide no teaching, suggestion, or motivation for the claimed method. Factory is a setup authoring tool that enables software developers to generate installation software to install the software on other systems. Importantly, Factory teaches a setup that is used for all systems on which the software is installed, and does not address the configuration of software once installed on a system. As described on page 9, the only selectivity in installations is the type of installation that is performed, such as complete, typical, minimum, and custom. These installation types are further described at pages 53-54, where it is again specifically states that "you give the user a choice of four different package groupings (called installation types)." Once the installation software is complete, the necessary files are generated in an installation package that is then used by end users to install the software. Importantly, the same installation package is used by the different end users regardless of the application of the end user. Factory contains no teaching or suggestion of different installation packages for different end users or different configurations of the software that are specific to an end user once installed.

Profit simply discloses an accounting software application. A user of Profit may set up bank accounts, accounts receivable, and the like. However, similarly to the disclosure in Factory, Profit has no teaching or suggestion of installation software that is generated based on questions that are entered for a first user. As noted at page 31 of the enclosed Profit software companion "For the most part, you don't have to make any decisions during the installation process" With respect to installation options, Profit provides only two options, namely express and custom. As indicated at page 31, and in Appendix C at page 355, express installation is a standard installation where files are placed into a default directory on the user's system. A custom installation is one in which a user may specify a directory where Profit is to be installed, and/or a user may skip installing, or install only, sample data files and online help files. The article referenced by the Examiner described various wizards that are included in the Profit software that are executed after the software is installed on a user's system. These wizards execute using the installed software to obtain standard information related to the user.

Further, Profit discloses an installation program usable by the first user. Claim 1, however, relates to the "development of the installation software." Profit has no teaching, disclosure, or suggestions regarding how the installation software is developed. Rather, Profit simply discloses using already developed installation software. The applicants respectfully submit that the Profit installation software is programmed line by line in a conventional manner and does not provide the steps outlined. In particular, because the installation software is likely programmed line by line in a conventional manner, it is unlike the claimed installation software is or needs to be

Art Unit: 2193

compiled. As can be seen from the above discussion of the cited references, there is no teaching, suggestion, or motivation for the method as claimed in claim 1. More specifically, because the references contemplate only a single installation setup for respective software applications regardless of the business of the end user, the cited references, alone or in combination, do not teach or suggest the steps of claim 1. Therefore, it is submitted that claim 1 is patentable over the cited references. Furthermore, claims 2-6 and 27 depend (directly or indirectly) from claim 1, and are therefore allowable for at least the same reasons as described with respect to claim 1. Independent claim 7 is directed to an apparatus for enabling the development of installation software wizards, comprising: (a) at least one memory; (b) at least one executable file stored in the at least one memory; (c) the at least one executable file comprising at least one instruction for providing at least one question definition screen; (d) a monitor; (e) at least one processing unit to execute the at least one instruction to display the at least one question definition screen to at least one intermediate user, the at least one processing unit includes at least one input so the at least one intermediate user can input at least a first question, the first question to solicit information from an end user relating to a business of the end user, such that the first end user can input business information specific to the first end user different than business information specific to a second end user and (f) a compiler to write all the received information, wherein the received information is saved for the first end user.

The cited references, as discussed above, contemplate only a single installation for any end user of the software product installed according to the references. Therefore, it is submitted that independent claim 7 is patentable over the cited references. Furthermore, claims 8-10 and depend (directly or indirectly) from claim 7, and are therefore allowable for at least the same reasons as described with respect to claim 7."

Examiner's Response

Examiner acknowledges Applicant's statement of not having readily available the reference repeatedly mentioned in the Specification. And Applicant's statement reflective of the level of knowledge they are required to know of commercial products for sale and for use such as the Microsoft product, "Profit" is not consistent with actual documentation for the product. (See the reference by Stephan L. Nelson). One of ordinary skill in the art is a hypothetical person who is presumed to be aware of all the pertinent part. *Customer Accessories Inc. v. Jeffrey-Allan Ind. Inc.*, 1 USPQ2d 1196 (Fed Cir. 1986).

"Independent claim 11 is directed to a computer program product comprising: a computer usable medium having a computer readable code embodied therein for processing data to develop installation software wizards to assist end users in installing business related software on a computer system of an end user, the computer usable medium comprising: (a) a question generation module configured to generate at least one question definition screen; (b) a receiving module configured to receive at least one question designed to solicit information from a first end user relating to a business of the first end user; (c) a determining module configured to determine whether the business related software requires additional information for the business related software installation for the first end user; (d) a linking module configured to provide links to next questions if additional information is determined to be needed to install the business related software for the first end user; (e) a saving module configured to save the at least one

Art Unit: 2193

received question; and (f) a compiling module configured to write the at least one received question saved by the saving module into the installation software wizard for the first end user. The cited references, as discussed above, contemplate only use of already developed installation software and a single installation for any end user of the software product installed according to the references. Therefore, it is submitted that independent claim 11 is patentable over the cited references. Furthermore, claims 12-13 and depend (directly or indirectly) from claim 11, and are therefore allowable for at least the same reasons as described with respect to claim 11."

"Independent claim 21 is directed to a method for generating a software installation application to install business related software where the business related software requires business operating information from an end user to be properly installed, the business related information being specific to a business of a specific end user and necessary to install the business related software package for the specific end user; the method comprising the steps performed on a computer of (a) identifying a plurality of business operating information necessary to install the business related software; (b) generating at least one edit question screen; the at least one edit question screen having a first input field for an intermediate user to enter at least one question designed to solicit business operating information from an end user; the at least one edit question screen having a second input field for the intermediate user to insert jump information, the jump information linking to at least one next question designed to solicit additional business operating information from the end user based on a plurality of possible answers from the end user to the at least one question; (c) inputting the at least one question and the jump information; (d) determining whether additional business operating information is necessary to complete installation of the business related software; (e) if additional information is necessary, generating a next question edit screen and inputting another at least one question and jump information; and (g) if additional information is not necessary, compiling a business software installation application using generated questions and linked generated next questions to solicit business operating information from the end user.

The cited references, as discussed above, contemplate use of already developed installation software and only a single installation for any end user of the software product installed according to the references. The references contain no teaching, suggestion or motivation for a business related software installation package that solicits business related information being specific to a business of a specific end user and necessary to install the business related software package for the specific end user. Therefore, it is submitted that independent claim 21 is patentable over the cited references. Furthermore, claims 22-26 and 28 depend (directly or indirectly) from claim 21, and are therefore allowable for at least the same reasons as described with respect to claim 21."

"Independent claim 29 is directed to a computer program product comprising: a computer usable medium having computer readable code embodied therein for processing data to create a business software installation application, the computer usable medium comprising: (a) a business information solicitation module configured to generate and display an edit question screen, the edit question screen having a first input field for an intermediate user to enter a plurality of questions designed to solicit business operating information from an end user

corresponding to a plurality of possible answers that are specific to the end user, and a second input field for the intermediate user to insert a plurality of jump information, the plurality of jump information corresponds to the plurality of possible answers and a business installation software application to a next question based on an answer to be provided by the end user; (b) an input module configured to accept input from the intermediate user regarding the plurality of questions, the plurality of possible answers, and the plurality of jump information; and (c) a compiling module configured to write the plurality of questions, the plurality of possible answers, and the plurality of jump information into the business software installation application. The cited references, as discussed above, contemplate use of already developed installation software and only a single installation for any end user of the software product installed according to the references. The references contain no teaching, suggestion or motivation of an intermediate user to enter a plurality of questions designed to solicit business operating information from an end user corresponding to a plurality of possible answers that are specific to the end user. Therefore, it is submitted that independent claim 29 is patentable over the cited references. Furthermore, claims 30-31 depend (directly or indirectly) from claim 29, and are therefore allowable for at least the same reasons as described with respect to claim 29."

"Independent claim 32 is directed to a computer program product: (a) a computer usable medium having computer readable code embodied therein for processing data to install a business software application, the computer usable medium comprising; (b) an identifying module configured to identify at least one software package to be installed; (c) a displaying module configured to display at least one question inputted by an intermediate user to solicit business operating information from at least a first end user needed to install the business software application on a system of the first end user; (d) an input module configured to receive the business operating information solicited by the displaying module; (e) a jump module configured to jump to a next question to solicit additional business operating information from the first end user needed to install the business software application, the jump module jumps to the next question based on jump information provided by the intermediate user and business operating information from the first end user; and (~ a system configuration module configured to install the business software application once necessary business operating information is received. The cited references, as discussed above, contemplate use of already developed installation software and only a single installation for any end user of the software product installed according to the references. Therefore, it is submitted that independent claim 32 is patentable over the cited references."

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Examiner has made available documentation on the commercial product Microsoft Profit and QuickBooks 99.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

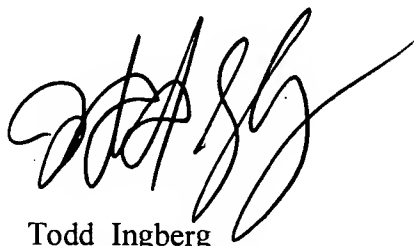
Correspondence Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week.

Art Unit: 2193

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is **571 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'TI' followed by a stylized flourish.

Todd Ingberg
Primary Examiner
Art Unit 2124

TI